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CLARK & ELBING LLP
101 FEDERAL STREET
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In re Application of:	:	
CLARK, Paul, T., et al.	:	
U.S. Application No.: 10/583,684	:	DECISION ON REQUEST UNDER
PCT No.: PCT/US2004/042743	:	37 CFR 1.497(d)
International Filing Date: 20 December 2004	:	
Priority Date: 19 December 2003	:	
Attorney's Docket No.: 07588/020002	:	
For: USE OF HUMAN CORD BLOOD-	:	
DERIVED PLURIPOTENT CELLS	:	
FOR THE TREATMENT FO DISEASE	:	

This decision is issued in response to the "Petition To Correct Inventorship Under 37 CFR 1.497(d)" filed 02 November 2006. Applicants have paid the required \$130 processing fee.

BACKGROUND

On 20 December 2004, applicants filed international application PCT/US2004/042743. The application claimed a priority date of 19 December 2003, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 19 June 2006. The published international application identified three applicant/inventors for the U.S.: Paul T. CLARK, Marc D. BEER, and Christoph M. ADAMS.

On 19 June 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, and Application Data Sheet (ADS), and an unexecuted declaration. The ADS and unexecuted declaration named the same three inventors as listed on the international application.

On 02 November 2006, applicants filed the "Petition To Correct Inventorship Under 37 CFR 1.497(d)" considered herein. The petition requests that Christoph M. ADAMS be removed as an inventor of record and that Morey KRAUS be added as an inventor of record. The petition was accompanied by, among other materials, a supplemental ADS and an executed declaration that identified the inventors as Morey KRAUS, Marc D. BEER, and Paul T. CLARK.

DISCUSSION

Section 1893.01(e) of the MPEP states the following regarding changes in the inventorship of an international application entering the national stage (emphasis added):

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92*bis*. See 37 CFR 1.41(a)(4). Accordingly, **an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied.** These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

As noted above, applicants have now filed an executed declaration that names an inventive entity different than that set forth in the international application (specifically, Morey KRAUS has been added as an additional inventor, and Christoph M. ADAMS has been removed). Accordingly, applicants must satisfy the requirements of 37 CFR 1.497(d) before such declaration can be accepted.

The "Petition To Correct Inventorship Under 37 CFR 1.497(d)" filed by applicants includes the required statements of non-deceptive intent from the persons being added and removed as inventors, as well as the required processing fee. Requirements (A) and (B) are therefore satisfied. However, applicants have not submitted the written consent of assignee Viacell, Inc. to the requested change in inventorship. Requirement (C) is therefore not satisfied.¹

Based on the above, applicants have failed to submit all the requirements of a grantable request under 37 CFR 1.497(d). Accordingly, the request to add Morey KRAUS as an additional inventor of record and to delete inventor Christoph M. ADAMS, is appropriately dismissed.

CONCLUSION

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The inventorship of record herein remains that set forth in the international application, that is, Paul T. CLARK, Marc D. BEER, and Christoph M. ADAMS.

The declaration filed 02 November 2006, which includes additional inventor Morey KRAUS and does not include Christoph M. ADAMS, is defective on the present record for failure to properly identify the inventors of record herein.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Request Under 37 CFR 1.497(d)" and must include the materials required to satisfy item (C) of a grantable petition, as

¹ It is noted that the assignee's consent must be submitted in compliance with 37 CFR 3.73(b).

discussed above and in the MPEP, that is, the written consent of the assignee to the proposed change of inventorship in the form required by 37 CFR 3.73(b).

Failure to file a proper response will result in abandonment of the application.
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents
of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459